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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/544,525    04/06/00    LUCHE

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EXAMINER

STEADMAN, D

ART UNIT

PAPER NUMBER

1652

*7*

DATE MAILED: 09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/544,525

Applicant(s)

LUCHE, RALF M.

Examiner

David J. Steadman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Status of the Application***

Claims 1-49 are pending in the application.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim(s) 1, drawn to a dual specificity phosphatase-3 (DSP-3) polypeptide, classified in class 435, subclass 195.
- II. Claim(s) 2-14, drawn to polynucleotides encoding and complementary sequences thereof, expression vectors, host cells, and a method for producing a DSP-3 polypeptide, classified in class 435, subclass 195.
- III. Claim(s) 15-21, drawn to an antibody that specifically binds a DSP-3 polypeptide, a pharmaceutical composition thereof, and a method for detecting DSP-3 expression in a sample using a DSP-3 antibody, classified in class 435, subclass 7.4.
- IV. Claim(s) 22-25, drawn to a method for detecting DSP-3 expression in a sample using a polynucleotide, classified in class 435, subclass 6.
- V. Claim(s) 26-29, drawn to a method for screening for an agent that modulates DSP-3 activity using a DSP-3 polypeptide, classified in class 435, subclass 6.
- VI. Claim(s) 30-32 and 42, drawn to a method for screening for an agent that modulates DSP-3 activity using a cell comprising a DSP-3 promoter, classified in class 435, subclass 21.

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- VII. Claim(s) 33 and 36-39, drawn to a method for modulating a proliferative response in a cell by contacting a cell with an agent that modulates DSP-3 activity, classified in class 435, subclass 375.
- VIII. Claim(s) 34 and 36-39, drawn to a method for modulating differentiation of a cell by contacting a cell with an agent that modulates DSP-3 activity, classified in class 435, subclass 377.
- IX. Claim(s) 35 and 36-41, drawn to a method for modulating survival of a cell by contacting a cell with an agent that modulates DSP-3 activity, classified in class 435, subclass 375.
- X. Claim(s) 43 and 44, drawn to a method for treating a patient afflicted with a disorder with DSP-3 activity by administering an agent that modulates DSP-3 activity, classified in class 514, subclass 789.
- XI. Claim(s) 45 and 46, drawn to a DSP-3 substrate trapping mutant polypeptide, classified in class 435, subclass 195.
- XII. Claim(s) 47-49, drawn to a method for screening a molecule for the ability to interact with DSP-3, classified in class 435, subclass 21.

The inventions are distinct, each from the other because:

2. The polypeptides of Groups I and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent structurally different polypeptides. Therefore,

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where structural identity is required such as for production of antibodies the different sequences have different effects.

3. The polynucleotide of Group II, the polypeptides of Groups I and XI, and the antibody of Group III each comprises a chemically unrelated structure capable of separate manufacture, use and effect. The polynucleotide of Group II has other utility besides encoding polypeptides such as a hybridization probe, the polypeptides of Groups I and XI can be made by another method such as *in vitro* synthesis, and the antibody of Group III can be used as an affinity purification reagent.

4. The polypeptides of Groups I and XI are unrelated to the method(s) of Groups IV and VI-X as they are neither used nor made by the method(s) of Groups IV and VI-X; the polynucleotide of Group II is unrelated to the method(s) of Groups V, VII-X, and XII as it is neither used nor made by the method(s) of Groups V, VII-X, and XII; and the antibody of Group III is unrelated to the method(s) of Groups IV-X and XII as it is neither used nor made by the method(s) of Groups IV-X and XII.

5. The polypeptides of Groups I and XI and the methods of Groups V and XII and the polynucleotide of Group II and the methods of Groups IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Groups I and XI can be used as antigens in the production of antibodies and the polynucleotide of Group II can be used for expressing the polypeptide of Group I.

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6. The methods of Groups IV-X and XII are independent as they comprise different steps, utilize different products and yield different results.
7. Because these inventions are distinct for the reasons given above and a separate search is required for each of the inventions listed as Groups I-XII, restriction for examination purposes as indicated is proper. "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02" (see MPEP 803). A search for the inventions listed as Groups I-XI requires divergent patent and non-patent literature and sequence searches, thus establishing a serious burden of search on the examiner.

### *Conclusion*

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934.

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The Examiner can normally be reached Monday-Friday from 7:30 am to 2:00 pm and from 3:30 pm to 5:30 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.



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